

**REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claims 1-7 and 10-31 remain pending in present application. Claims 8 and 9 have been cancelled. Claims 1, 10, 17, 24 and 29 have been amended.

The independent claims have been amended to include reference to texturally distinct areas, which was found in original claim 29 as well as to indicate the thickness of the coating that is used to provide the tactile or aesthetic features of the present invention. Claims 1, 10, 17 and 24 have been further amended to indicate that the percentage of the starch component ranges from between 2 to 50% by weight of the coating which was provided in original claim 9. The claims have not been amended in such a manner as to expand or change the scope.

The present invention includes a starch component in a varnish or glossy overcoat to provide aesthetic, textural or tactile features as well as to contain odors of the varnish overcoating. None of the applied references teach or disclose what is provided in the present invention.

Claims 1-5, 10-11, 13-15, 17 and 19-23 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Spector (US 5,951,057). Reconsideration and withdraw of the rejection is earnestly solicited. "A claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently described, in a single, prior art reference." Verdegaal Bros. V. Union Oil Co., of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Spector does not anticipate the claims of the present invention. Spector discloses a greeting card that has a detachable decal section which carries an image which is printed in a transferable ink that can be transferred to a receptive surface (column 1, lines 6-10). Spector does not disclose or teach the use of a substrate as a business communication as required by the claims. Transferable decals or tattoos are not business communications. Transferable decals are similar to premiums, or toys, that are commonly offered in consumer product containers such as ready to eat cereal boxes.

Spector does not disclose the application of a coating over at least a portion of the printed image as required by the claims of the present invention. Rather, the adhesive layer 20 is provided under the layer upon which the printed image is produced, see FIGURE 5 of Spector which clearly illustrates the adhesive layer 20 on the backside of the layer which the image is printed. That is, the image in FIGURE 5 is shown in reverse which indicates the image is being viewed from the underside on which the coating layer 20 has been applied. As such, Spector does not anticipate the claims 1 and 10. In addition, with respect to claim 17, the coating 20 of Spector does not produce raised areas as required by the claim, as such raised areas would in all likelihood not permit the tattoo or decal to be adhered to the surface without bubbling or ridges. Nor would it be obvious to modify Spector to permit the adhesive coating over the image as to do so would not permit the decal to be adhered to a surface.

Spector also discloses that the use of starch in Spector is as an adhesive the "water soluble adhesive layer 20 which may be a water-based acrylic or a starch of the type used in mailing envelopes" (column 4, lines 12-14). In order to remove the decal, the adhesive layer is exposed to moisture or water which causes the adhesive layer to dissolve (column 4, lines 30-33). Applying or flooding the starch containing coating of the present invention with water as required by Spector (in order to permit the transfer of the decal) would destroy the present invention as the coating is not intended to be separable from

the substrate of the present invention. Nor is the coating layer on the surface of the business communication intended to be dissolved as required by Spector. "It is impermissible to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggest to one skilled in the art" Bausch & Lomb, Inc. v. Barnes-Hind Hydorcurve, Inc., 796 F.2d 443, 448 (Fed. Cir. 1986). "In its consideration of the prior art, however, the district court erred --- in disregarding disclosure in the references that diverge from and teach away from the invention at hand. *In re W.L. Core & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983).

Spector simply does not anticipate the claims of the present invention either before or after amendment. There is no disclosure in Spector concerning the coating being applied over the surface of the image, the thickness of the coating, or the percentage by weight of the starch component of the coating. Spector does also not disclose the use of the coating layer to provide raised areas tactile properties or to conceal the odor of the coating layer. Spector simply does not anticipate the claims, either before or after the amendment, of the present invention as each and every element of the claims is not found in the reference as required by section 102.

Claims 24-31 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Fujita et al (5,217,791). Reconsideration and withdraw of the rejection is earnestly solicited.

Fujita et al do not anticipate claim 24 as there is no disclosure with respect to creating a substrate that has improved surface affinity for enhanced feeding and handling as set forth in the preamble of the claim and now as additionally recited in the body of the claim.

Fujita et al relate to a transparent film that is used for window displays such as “stained glass” (column 2, line 7) so that the image is visible from both sides of the window (column 2, lines 13-14). The visibility of the image through both sides of the sheet is permitted due to absorption of the ink into the coating layer, see column 2, lines 50-52 and column 3, lines 50-57. The coating applied to the present invention as recited in claims 24 and 29 is used to create surface discontinuities to improve sheet feeding or create textural features on the sheet. There is no disclosure in Fujita et al concerning the creation of surface discontinuities on the face of the sheet to produce textural features on the surface of the sheet. As such, Fujita et al do not anticipate the claims of the present invention.

Claims 1, 6-9, 12, 16 and 18 have been rejected under 35 USC 103(a) as being unpatentable over Spector in view of Young et al (4,079,025). Reconsideration and withdraw of the rejection is earnestly solicited.

Young et al disclose a composition that is used in creating photosensitive products, such as photographic plates and other articles. Once the coating is applied it is subjected to a “photosensitive process” (column 19, lines 3-4) or other “etching and electroplating resists” (column 19, lines 23-23). The coating is used to create shielded and unshielded areas so that the two areas can be separated from one another “by conventional means (e.g. water washing, etc.) to provide the desired pattern or image” (column 19, lines 37-40). Young et al has nothing whatsoever to do with end products produced from such technology, e.g. business forms, greeting cards, etc. These items, such as business forms, greeting cards, etc. can be an end product of various printing technologies that use a printing plate.

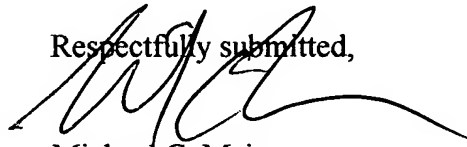
As previously discussed, Young et al is not pertinent to the present invention in that Young et al do not disclose a printed substrate suitable for use as a business

communication, e.g. a business form, greeting card, etc. Instead, Young et al discloses a coating that is used in making photosensitive plates, such as those that may be used in preparing printing plates for lithographic, offset and other printing technologies. That is, Young et al relate to a coating that is used in connection with preparing a printing plate that is used in printing equipment to produce a printed product. This is not the field of endeavor to which the instant invention is directed. The instant invention relates to the printed product, e.g. business form, presentation folder or greeting card, a completed product of a printing technology rather than a component used in manufacturing printed products.

If one were to combine the teachings of Young et al with Spector as suggested by the Examiner, then the areas of Spector provided with the starch based coating would be etched away to reveal a pattern, as taught by Young et al., such as in the preparation of a printing plate. Such a process would simply destroy Spector as to remove the coated portions would then not permit Spector to function as a decal as the adhesive portions used by Spector to adhere the decal to the surface would have been removed by the etching process. The Examiner "may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis." Ex parte Haymond, 41 U.S.P.Q.2d 1217, 1220 (Bd. Pat. App. & Int. 1996). Furthermore, the Examiner must support the allegation of a suggestion or motivation in the art for the combination with a specific cite to some portion of a cited reference, as "obviousness cannot be predicated on what is unknown." In re Rijckaert, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited. The Examiner is encouraged to contact the undersigned in the event any small matters remaining outstanding so as to eliminate the necessity of another action and response.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael C. Maier', written over the typed name.

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